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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,996	09/15/2003	Takashi Kawasaki	0828.68359	2241

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EXAMINER	
MURDOUGH, JOSHUA A	

ART UNIT	PAPER NUMBER
3621	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/662,996	KAWASAKI ET AL.	
	Examiner	Art Unit	
	JOSHUA MURDOUGH	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *21-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *21-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *9/10/2007*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Acknowledgements

1. The Examiner for this case has changed. Please note that the Examiner of record is Joshua Murdough in any future correspondence.

2. As per Applicant's amendment on 28 December 2007:

Claims 1-20 are now canceled.

Claims 21-26 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 December 2008 has been entered.

Claim Rejections - 35 USC § 112 2nd Paragraph

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

6. The term "fixedly" in claims 21-26 is a relative term which renders the claim indefinite. The term "fixedly" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is not understood what it takes for data to be fixedly recorded. Is it fixedly recorded if it is merely stored through the removal of power? If not, is locking it as can be done with a floppy disk or memory card? Or does it need to be permanently recorded, such as a CD-ROM or a hardwired input?

7. For purposes of compact prosecution, the Examiner has interpreted this limitation to mean that the data has been stored in some type of persistent memory.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. Claims 21, 23, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra et al. (US 6,189,146) ("Misra") in view of Christiano (US 5,671,412).

10. As to claim 21, Misra shows:

A software execution management device for managing an execution status of software whose execution is restricted by a license, comprising:

a recording medium on which device identification information is fixedly recorded (Figure 3, element 142), the device identification information uniquely identifying the software execution management device (Figure 3, element 28)

license information storing means (Figure 3, element 112) storing license information including an encrypted software decryption key for decrypting the software provided in an encrypted state and a number of computers that can execute the software simultaneously (Columns 6-7, lines 65-12);

identification information determining means (Figure 3, element 124) for determining whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same, when receiving an execution permission determination request from a computer connected via a network (Figure 3, element 126);

executing computer quantity determining means (Figure 3, element 108; Column 9, lines 9-10) for monitoring a number of executing computers executing the software, and when receiving the execution permission determination request, determining whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

software key decrypting means (Figure 3, element 128) for decrypting the software decryption key included in the license information with the key-specific encryption key when the identification information determining means determines sameness and the executing computing quantity determining means determines

that the number of computers that can execute the software simultaneously is greater than the number of executing computers (Figure 4, step 164); and

decryption key managing means (Figure 3, element 136) for giving the software decryption key decrypted by the software key decrypting means to the computer (Figure 3, element 30) issuing the execution permission determination request (Figure 3, element 132).

Misra does not show:

hardware key connection means for reading attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification information specifying a permitted device, the hardware key storing the attach/detach key information;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano because it was a well known and it provided better security than a license alone.

11. As to claim 23, Misra shows:

A software execution management method for a software execution management device managing an execution status of software whose execution is restricted by a license, wherein:

identification information determining means (Figure 3, element 124) is provided with a recording medium on which device identification information is fixedly recorded(Figure 3, element 142), and determines whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same when receiving an execution permission determination request from a computer connected via a network (Figure 3, element 126), the device identification information uniquely identifying the software execution management device (Figure 3, element 28);

executing computer quantity determining means (Figure 3, element 108;Column 9, lines 9-10) is provided with license information storing means storing license information including an encrypted software decryption key for decrypting the software provided in an encrypted state and a number of computers that can execute the software simultaneously, and monitors a number of executing computers executing the software , and when receiving the execution permission determination request, determines whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

software key decrypting means (Figure 3, element 128) decrypts the software decryption key included in the license information with the attach/detach key-specific encryption key read from the hardware key when the identification information determining means determines sameness and the executing computing quantity determining means determines that the number of computers that can execute the

software simultaneously is greater than the number of executing computers (Figure 4, step 164); and

decryption key managing means (Figure 3, element 136) gives the software decryption key decrypted by the software key decrypting means to the computer (Figure 3, element 30) issuing the execution permission determination request(Figure 3, element 132).

Misra does not show:

hardware key connection means reads attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification information specifying a permitted device, the hardware key storing the attach/detach key information;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano because it was a well known and it provided better security than a license alone.

12. As to claim 25, Misra shows:

A computer-readable recording medium storing a software execution management program for managing an execution status of software whose execution is restricted by a license, the software execution management program causing a

computer provided with a recording medium having fixedly recorded thereon device identification information uniquely identifying the computer to operate as:

a license information storing unit (Figure 3, element 112) storing license information including an encrypted software decryption key for decrypting the software provided in an encrypted state and a number of computers that can execute the software simultaneously (Columns 6-7, lines 65-12);

an identification information determining unit (Figure 3, element 124) for determining whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same when receiving an execution permission determination request from an execution target computer connected via a network (Figure 3, element 126);

an executing computer quantity determining unit (Figure 3, element 108; Column 9, lines 9-10) for monitoring a number of executing computers executing the software, and when receiving the execution permission determination request, determining whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

a software key decrypting unit (Figure 3, element 128) for decrypting the software decryption key included in the license information with the key-specific encryption key read from the key when the identification information determining unit determines sameness and the executing computing quantity determining unit determines that the number of computers that can execute the software

simultaneously is greater than the number of executing computers (Figure 4, step 164); and

a decryption key managing unit (Figure 3, element 136) for giving the software decryption key decrypted by the software key decrypting unit to the execution target computer (Figure 3, element 30) issuing the execution permission determination request (Figure 3, element 132).

Misra does not show:

a hardware key connection unit for reading attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification information specifying a permitted device, the hardware key storing the attach/detach key information;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano because it was a well known and it provided better security than a license alone.

13. Claims 22, 24, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Misra and Chritiano and further in view of Long et al. (US 4,926,315) ("Long").

14. As to claim 21, Misra shows:

A software execution management device for managing an execution status of software whose execution is restricted by a license, comprising:

a recording medium on which device identification information is fixedly recorded (Figure 3, element 142), the device identification information uniquely identifying the software execution management device (Figure 3, element 28)

license information storing means (Figure 3, element 112) storing license information including an encrypted software decryption key for decrypting the software provided in an encrypted state and a number of computers that can execute the software simultaneously (Columns 6-7, lines 65-12);

first identification information determining means (Figure 3, element 124) for determining whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same, when receiving an execution permission determination request from a computer connected via a network (Figure 3, element 126);

executing computer quantity determining means (Figure 3, element 108; Column 9, lines 9-10) for monitoring a number of executing computers executing the software, and when receiving the execution permission determination request, determining whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

software key decrypting means (Figure 3, element 128) for decrypting the software decryption key included in the license information with the key-specific encryption key when the identification information determining means determines

sameness and the executing computing quantity determining means determines that the number of computers that can execute the software simultaneously is greater than the number of executing computers (Figure 4, step 164); and

decryption key managing means (Figure 3, element 136) for giving the software decryption key decrypted by the software key decrypting means to the computer (Figure 3, element 30) issuing the execution permission determination request (Figure 3, element 132).

Misra does not show:

hardware key connection means for reading attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification information specifying a permitted device, the hardware key storing the attach/detach key information;

second identification information determining means for determining whether the second device identification information included in the execution permission determination request matches anyone piece of chassis identification information included in the license information when receiving the execution permission determination request;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Long shows the formulation and comparison of a hard-wired chassis ID (Figure 26). Therefore it

would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano, and the chassis ID of Long in a the determining means of Misra for determining the key validity. The inclusion of the key would have been obvious because it provided better security than a license alone, and the use of the chassis ID in the determining means of Misra would have been obvious because it could have been performed without departing from the scope of Misra's invention and would allow for greater flexibility in for defining rules by the licensor.

15. As to claim 24, Misra shows:

A software execution management method for a software execution management device managing an execution status of software whose execution is restricted by a license, wherein:

first identification information determining means (Figure 3, element 124) is provided with a recording medium on which device identification information is fixedly recorded(Figure 3, element 142), and determines whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same when receiving an execution permission determination request from a computer connected via a network (Figure 3, element 126), the device identification information uniquely identifying the software execution management device (Figure 3, element 28);

executing computer quantity determining means (Figure 3, element 108;Column 9, lines 9-10) is provided with license information storing means storing license information including an encrypted software decryption key for decrypting the

software provided in an encrypted state and a number of computers that can execute the software simultaneously, and monitors a number of executing computers executing the software , and when receiving the execution permission determination request, determines whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

software key decrypting means (Figure 3, element 128) decrypts the software decryption key included in the license information with the attach/detach key-specific encryption key read from the hardware key when the identification information determining means determines sameness and the executing computing quantity determining means determines that the number of computers that can execute the software simultaneously is greater than the number of executing computers (Figure 4, step 164); and

decryption key managing means (Figure 3, element 136) gives the software decryption key decrypted by the software key decrypting means to the computer (Figure 3, element 30) issuing the execution permission determination request(Figure 3, element 132).

Misra does not show:

hardware key connection means reads attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification

information specifying a permitted device, the hardware key storing the attach/detach key information;

second identification information determining means is provided with license information storing means storing license information including at least one piece of chassis identification information, an encrypted software decryption key for decrypting the software provided in an encrypted state, and a number of computers that can execute the software simultaneously, and determines whether the second device identification information included in the execution permission determination request matches anyone piece of chassis identification information included in the license information when receiving the execution permission determination request, the chassis identification information specifying a chassis on which a plurality of computers can be mounted and that is permitted to execute the software with a computer mounted thereon;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Long shows the formulation and comparison of a hard-wired chassis ID (Figure 26). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano, and the chassis ID of Long in a the determining means of Misra for determining the key validity. The inclusion of the key would have been obvious because it provided better security than a license alone, and the use of the chassis ID in the determining means of Misra would have been obvious because it could

have been performed without departing from the scope of Misra's invention and would allow for greater flexibility in for defining rules by the licensor.

16. As to claim 26, Misra shows:

A computer-readable recording medium storing a software execution management program for managing an execution status of software whose execution is restricted by a license, the software execution management program causing a computer provided with a recording medium having fixedly recorded thereon device identification information uniquely identifying the computer to operate as:

a license information storing unit (Figure 3, element 112) storing license information including an encrypted software decryption key for decrypting the software provided in an encrypted state and a number of computers that can execute the software simultaneously (Columns 6-7, lines 65-12);

an identification information determining unit (Figure 3, element 124) for determining whether the permitted device identification information included in the key (client image, client signature, figure 3) and the device identification information are same when receiving an execution permission determination request from an execution target computer connected via a network (Figure 3, element 126);

an executing computer quantity determining unit (Figure 3, element 108; Column 9, lines 9-10) for monitoring a number of executing computers executing the software, and when receiving the execution permission determination request, determining whether the number of computers that can execute the software simultaneously is greater than the number of executing computers (Column 12, lines 41-55);

a software key decrypting unit (Figure 3, element 128) for decrypting the software decryption key included in the license information with the key-specific encryption key read from the key when the identification information determining unit determines sameness and the executing computing quantity determining unit determines that the number of computers that can execute the software simultaneously is greater than the number of executing computers (Figure 4, step 164); and

a decryption key managing unit (Figure 3, element 136) for giving the software decryption key decrypted by the software key decrypting unit to the execution target computer (Figure 3, element 30) issuing the execution permission determination request (Figure 3, element 132).

Misra does not show:

a hardware key connection unit for reading attach/detach key information from a hardware key when the hardware key is attached, the attach/detach key information including an attach/detach key-specific encryption key and permitted device identification information specifying a permitted device, the hardware key storing the attach/detach key information;

a second identification information determining unit for determining whether the second device identification information included in the execution permission determination request matches anyone piece of chassis identification information included in the license information when receiving the execution permission determination request;

However, Christiano shows that hardware key devices were known, particularly in the area of business (multi-user) software licensing (Column 1, lines 15-48). Since the use of the hardware key was known, the use of a connection means must have also been inherently known. Long shows the formulation and comparison of a hard-wired chassis ID (Figure 26). Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified the teachings of Misra to include the hardware key of Christiano, and the chassis ID of Long in a the determining means of Misra for determining the key validity. The inclusion of the key would have been obvious because it provided better security than a license alone, and the use of the chassis ID in the determining means of Misra would have been obvious because it could have been performed without departing from the scope of Misra's invention and would allow for greater flexibility in for defining rules by the licensor.

Claim Interpretation

17. Applicants are reminded "[A]pparatus claims cover what a device *is*, not what a device *does*." (MPEP 2114) (emphasis in original) Therefore, "[a] claim containing a 'recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus' if the prior art apparatus teaches all the structural limitations of the claim." (MPEP 2114) Applicants are advised that reciting "…unit for…," as done most notably in claims 25 and 26, suggests that the limitations following the phrase could be intended use and therefore may be given less weight than desired.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOSHUA MURDOUGH whose telephone number is (571)270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

19. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

20. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

J. M.
Examiner, Art Unit 3621

/Jalatee Worjloh/
Primary Examiner, Art Unit 3621